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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/627,018	07/27/2000	Helmut Weber	70442.1201	9975

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Peter A Sullivan  
Ronald Abramson  
Hughes Hubbard & Reed LLP  
One Battery Park Plaza  
New York, NY 10004

EXAMINER

THALER, MICHAEL H

ART UNIT PAPER NUMBER

3731


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DATE MAILED: 07/02/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

ON

# Office Action Summary

Application No. <b>09/627,018</b>	Applicant(s) <b>Weber et al.</b>	
Examiner <b>Michael Thaler</b>	Art Unit <b>3731</b>	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1)  Responsive to communication(s) filed on \_\_\_\_\_
- 2a)  This action is FINAL.                      2b)  This action is non-final.
- 3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

### Disposition of Claims

- 4)  Claim(s) 1-8 \_\_\_\_\_ is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5)  Claim(s) \_\_\_\_\_ is/are allowed.
- 6)  Claim(s) 1-8 \_\_\_\_\_ is/are rejected.
- 7)  Claim(s) \_\_\_\_\_ is/are objected to.
- 8)  Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9)  The specification is objected to by the Examiner.
- 10)  The drawing(s) filed on Jul 27, 2000 is/are a)  accepted or b)  objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11)  The proposed drawing correction filed on \_\_\_\_\_ is: a)  approved b)  disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12)  The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13)  Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a)  All b)  Some\* c)  None of:
- Certified copies of the priority documents have been received.
  - Certified copies of the priority documents have been received in Application No. \_\_\_\_\_
  - Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

- 14)  Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
- a)  The translation of the foreign language provisional application has been received.
- 15)  Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1)  Notice of References Cited (PTO-892)                      4)  Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)                      5)  Notice of Informal Patent Application (PTO-152)
- 3)  Information Disclosure Statement(s) (PTO-1449) Paper No(s). 2                      6)  Other:

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The disclosure is objected to because of the following informalities: The specification should be in single column format as set forth in MPEP 1411. Many of claims 1-7 include changes relative to the patented claims which are not designated by underlining or brackets as they should be. For example, many of the amendments made in the Feb. 24, 1999 amendment in the parent application (which were incorporated into the patented claims) are not present in the instant claims. On page 8, line 7, "Figure 11 A" is incorrect since this figure is not in the application. In claim 5, line 3, the quotation marks should be deleted. Appropriate correction is required.

The reissue oath/declaration filed with this application is defective (see 37 CFR 1.175 and MPEP § 1414) because it fails to identify the citizenship as well as the residence and mailing address of inventor Gernot Weber as required by 37 CFR 1.63 (a) (3) and (c).

Claims 1-8 are rejected as being based upon a defective reissue declaration under 35 U.S.C. 251 as set forth above. See 37 CFR 1.175. The nature of the defect(s) in the declaration is set forth in the discussion above in this Office action.

Claims 1-7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claim 1, lines 5-8 are confusing and inaccurate

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since the top shaft cutting piece is not advanced and retracted when the front handle piece is compressed. In claim 5, lines 2-3 are confusing and are not understood.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claim 8 is rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Falk (4,994,024). Falk discloses a convertible rongeur (The Falk instrument is a rongeur since it cuts cartilage and bone as described in col. 1, lines 34-37.) comprising front handle piece 10, bottom shaft piece 4, 3, 5, 1a (which is bottom since it is generally below the top shaft cutting piece 11, 9) having tip

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portion (the distal portion of jaw 4 which has a reduced height as compared with the proximal portion as seen in figure 2) and handle portion 1a, top shaft cutting piece 11, 9 moveably engaged with the tip portion (Portion 11 of the top shaft cutting piece 11, 9 is moveably engaged with the sides of the tip portion as jaw portion 11 opens and closes since figure 3 shows jaw portion 11 contacting the sides of the tip portion at 4.), the top shaft cutting piece being disengageable with the tip portion (when the jaw is completely open as shown in figure 2) wherein, when the top shaft cutting piece is disengaged from the tip portion, the top shaft cutting piece remains attached to the rongeur so as to retain all parts of the rongeur in one attached unit. Alternatively, it would have been obvious that portion 11 of the top shaft cutting piece 11, 9 is moveably engaged with the sides of the tip portion as jaw portion 11 opens and closes since figure 3 shows jaw portion 11 contacting the sides of the tip portion at 4. Alternatively, member 11 alone may be considered to be the claimed top shaft cutting piece.

Claims 1-7 are free of any rejection based upon the prior art of record.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Thaler whose telephone number is (703) 308-2981. The examiner can normally be reached Monday to Friday.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael J. Milano can be reached on (703)308-2496. The fax phone numbers for the organization where this application or proceeding is assigned are (703)305-3590 for regular communications and (703)305-3590 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-0858.

mht  
June 24, 2003



MICHAEL THALER  
PRIMARY EXAMINER  
ART UNIT 3731